

REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on July 24, 2003, and the references cited therewith. Claim 29 has been amended; as a result, claims 1-7, 9-18 and 20-36 are now pending in this application. Applicant does not admit that the cited references are prior art and reserves the right to "swear behind" each of the cited references as provided under 37 C.F.R. 1.131.

The Office Action indicated a discrepancy between the new claims added (25-36) and the indication in the Remarks section that only claims numbering up to 28 were pending. The Office Action indicated that "[i]n the spirit of compact prosecution, the Examiner has proceeded assuming that all of the new claims are to be considered." See Office Action at ¶4. Further, the Office Action indicated that "Applicant must confirm that claims 25-36 have been added." Office Action at ¶4. Applicant thanks the Examiner for pointing out such discrepancy and examining said claims. Applicant confirms that claims 25-36 are pending in this application.

Interview

Applicant's representative, Gregg A. Peacock, spoke with Examiner Joseph P. Hirl, on November 24, 2003. Applicant's representative requested an interview with Examiner Hirl prior to the next Office Action and will call to set up a meeting on or around December 15, 2003.

Claim Rejections – 35 U.S.C. § 101

Claims 29-32 were rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. In particular, the Office Action indicated that "[t]he practical application test requires that a useful, concrete and tangible result be accomplished." Office Action at ¶8. Claims 29-32 represent abstract methodology and therefore are intangible. Applicant has amended claim 29 to recite "modifying at least one of the steps of the recipe based on the identifying of the one or more modifications."

Accordingly, a tangible result is achieved based on the modification of at least one of the steps of the recipe. In light of such amendment, Applicant respectfully submits that the rejection of claim 29 has been overcome and that this claim is in condition for allowance. Because claims 30-32 depend from and incorporate this amended limitation, Applicant respectfully submits that

the rejection of claims 30-32 have been overcome and that these claims are in condition for allowance.

Claim Rejections – 35 U.S.C. § 102

Claims 1-7, 9-17, and 20-24 were rejected under 35 USC § 102(e) as being anticipated by Kohn et al.(U.S. Patent No. 5,963,447). Applicant respectfully traverses these rejections. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). MPEP 2131.

With regard to claim 1, among the differences, such claim recites "annotating one or more actions in the production recipe with a desired intention for the action." In the "Response to Arguments" section, the Office Action maintains its previous rejection in the Office Action mailed December 13, 2002 citing a description of the behavior statement in Kohn at column 18, lines 57-59. In maintaining the previous rejection, the Office Action is alleging that "[w]ithout such annotation (intention of operation), Kohn's Invention could not function."

Accordingly, the Office Action is asserting that the system of Kohn is inoperable with annotations regarding intention of operation. Applicant respectfully traverses this allegation and submits that if these annotations were needed to operate the system of Kohn, such annotations would at least be disclosed a single time in the description of the system. However, the Office Action fails to point to any part of the description that describes something (these annotations) that is needed in order for the system to operate. Accordingly, Applicant respectfully submits that annotations for intention of operation is not required to operate the system of Kohn.

With regard to the remarks related to inherency of such limitation in Kohn, the Office Action indicated that

[t]he Examiner, when appropriate, will provide to the Applicant an opinion for the sake of clarification that will convey the understanding of one of ordinary skill in the art and could very well be related to inherency. . . . The Examiner states that inherency is not synonymous with conclusory. See Office Action at page 5.

As set forth by the Federal Circuit,

For a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art Although this disclosure requirement presupposes the knowledge of one skilled in the art of the claimed invention, that presumed knowledge does not grant a license to read into the prior art reference teachings that are not there. (emphasis added) *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 43 USPQ 2d 1481, 1490 (Fed. Cir. 1997).

Applicant respectfully submits that one of ordinary skill in the art would not annotate a desired intention for an action of a production recipe based on a system that only discloses the generation of “a statement representing the desired behavior.” Kohn at column 18, lines 57-59. Behavior is defined as “the way something function or operates.” *Merriam-Webster Dictionary* 2003. Intention is defined as “what one intends to do or bring about”, wherein intend is defined as “to have in mind as a purpose or goal.” *Merriam-Webster Dictionary* 2003. Therefore, “behavior” relates to the “how” of an operation, while “intention” relates to the purpose of goal of such operation.

Therefore, Applicant respectfully submits that the rejection of claim 1 has been overcome and that this claim is in condition for allowance. Because claim 2 depends from and further defines claim 1, Applicant respectfully that the rejection of claim 2 have been overcome and that this claim is in condition for allowance.

With regard to claim 3, among the differences, such claim recites “generating through computer automated operations a recipe comprising a set of actions and the purpose of the underlying process.” In the “Response to the Arguments” section, the Office Action maintained its position set forth in the Office Action mailed December 13, 2002 and submitted the following statements:

To one of ordinary skill in the art, it is recognized that technology builds on technology and any given piece of art, merely represents that which is new or noteworthy at that moment in time. Such new technology will indeed become the support (inherency) for yet another piece of art. Office Action at page 6.

The relevancy and basis for such statements are unclear. However, Applicant assumes that this is the basis for maintaining the inherency rejection under 35 U.S.C. 102. The Office Action then recites the following from Kohn:

The Model Builder Realization 51 contains clauses that constitute a recipe for building a procedural model (automation) for generating a variable instantiation and theorem proving. Kohn at column 21, lines 39-42.

However, as in other recitations from Kohn, this recitation does not describe generating a recipe that comprises the purpose of the underlying process. Purpose is defined as “something set up as an object or end to be obtained.” *Merriam-Webster Dictionary* 2003. Applicant respectfully submits that the recitations in Kohn neither explicitly nor inherently disclose a recipe that comprises the end to be obtained for the underlying process.

Accordingly, Applicant respectfully submits that the rejection of claim 3 has been overcome and that this claim is in condition for allowance. Because claims 4-5 depend from and further define claim 3, Applicant respectfully that the rejection of claims 4-5 have been overcome and that these claims are in condition for allowance.

With regard to claim 6, among the differences, claim 6 recites “modifying a recipe for a batch processing situation using the data stored in the knowledge repository, wherein the recipe contains steps and purposes.” In light of the remarks set forth above concerning claim 3, Applicant respectfully submits that the rejection of claim 6 has been overcome and that this claim is in condition for allowance. Because claim 7 depends from and further defines claim 6, Applicant respectfully that the rejection of claim 7 has been overcome and that this claim is in condition for allowance.

With regard to claim 9, among the differences, claim 9 recites “a Structured Knowledge Repository to store and organize the knowledge, wherein the Structured Knowledge Repository organizes knowledge and provides links between specific pieces of information and the functional purposes to which the knowledge can be put.” In light of the remarks set forth above concerning claim 3, Applicant respectfully submits that the rejection of claim 9 has been overcome and that this claim is in condition for allowance. Because claims 10-17 and 20-22

depend from and further define claim 9, Applicant respectfully that the rejection of claims 10-17 and 20-22 have been overcome and that these claims are in condition for allowance.

Claim Rejections – 35 U.S.C. § 103

Claim 18 was rejected under 35 USC §103(a) as being unpatentable over Kohn et al. in view of Acknowledged Prior Art (U.S. Patent No. 5,963,447, referred to as Kohn; Specification, referred to as Acknowledged Prior Art, APA).

In the “Response to Arguments” section, the Office Action refutes that previous Office Actions do not indicate that Kohn does not teach “abstraction-decomposition space techniques.” See Office Action at pages 7-8. Please see the page 13 of the current Office Action, which recites the remarks from prior Office Actions:

Kohn does not teach structured knowledge repository uses abstraction-decomposition space (ADS) techniques.

The Office Action indicated that the rejection from the prior office actions still apply. In particular, the Office Action mailed December 13, 2002 stated that “[t]o one of ordinary skill in the art such as an engineer that is accustomed to solving problems, the combination of Kohn with APA is not elusive [and] [f]or sure, artificial intelligence is cognitive work.” Office Action at page 6.

Applicant traverses this rejection. As set forth in the prior response to the Office Action mailed on April 11, 2002, “[t]he Office Action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *In re Sang Su Lee*, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Applicant respectfully submits that the remarks in the “Response to Arguments” section are conclusory such that the Office Action has not provided objective evidence for a suggestion or motivation to combine Kohn with the Applicant’s specification (which is referred to by the Office Action as APA). Therefore, Applicant respectfully submits that the Office Action did not make out a *prima facie* case of obviousness for claim 18.

Allowable Subject Matter

Applicant acknowledges and thanks the Examiner for the allowance of 25-28 and 33-36.

Serial Number: 99/549620

Filing Date: April 14, 2000

Title: ADVANCED RECIP

Title: ADVANCED RECIPE - A KNOWLEDGE BASED INFORMATION SYSTEM FOR PRODUCTION PROCESSES

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 371-2103 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account
No. 19-0743

Respectfully submitted,

ANOOP K. MATHUR ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 371-2103 /

Date 11-24-03

By Gregg A. Peacock
Reg. No. 15,001

Gregg A. Peacock
Reg. No. 45,001

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 24 day of September 2003.

Gina M. Uphus

Name _____

Signature

Gena Uphus